

Remarks

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Thus, the claims have been amended in response to the rejection under the second paragraph of 35 U.S.C. §112. Insofar as this rejection is maintained, it is respectfully traversed.

The following numbered items correspond to those set forth by the Examiner in connection with this rejection.

1. Definition of L.

The Examiner indicates that L is "a moiety". Applicants respectfully point to the description at page 13, lines 12-28 wherein L is properly defined, as a "probe", a "molecule", a "library of molecules", a "nucleic acid", a "lipid" or a "biomolecule", and the like, depending on the particular property of the label. Applicants have previously amended the definition of label in the claim to read "moiety" to make it clear that the label is not a molecule by itself, but a molecule connected to a linker R₄. "A lipid or other hydrophobic moiety" is a moiety, not a molecule. To make this unambiguous, Applicants have now changed this expression to "a lipid moiety or other hydrophobic moiety".

2. L as a plurality of labels.

In the description at page 5, line 24, L is defined as a label, a plurality of the same or different labels, or a bond, or a further group. Together with this text it is clear that L can have the meaning of a plurality of labels. Furthermore, on page 10, lines 10 and 11, it is defined that "A linker group R₄ is preferably a flexible linker connecting a label L or a plurality of same or different labels L to the substrate". Likewise on page 13, lines 1 to 3, it is described that "A linker R₄ may carry one or more same or different labels". This makes it clear that R₄ is not restricted to a linker carrying only one label, although this is one particular embodiment reflected in R₄ being an "alkylene" group. There is no need to amend the formula since L may have the meaning "plurality of labels". To make this unambiguous, Applicants have inserted "connected to R₄" after "plurality of same or different labels".

3. List of labels in claim 2.

On reading claim 2 there can be no doubt what belongs to the definition of L. Applicants include a structuring of this definition in paragraphs, which visually illustrates this.

4. Moiety with membrane-inserting moiety.

In the context of the description as a whole it is clear to the skilled person in the art what a lipid with membrane-inserting properties or other hydrophobic molecule with membrane-inserting properties is. To make this unambiguous, “membrane” is changed to “cell membrane”.

5. One part of specific binding pair.

On page 14, line 7/8, examples of specific binding pairs are given, namely biotin/avidin and biotin/streptavidin. Claim 2 is amended by deleting “one part of a specific binding pair”, because this expression is duplicated by the particular moieties biotin, avidin and streptavidin listed.

- 6./7. Claim 28 is deleted.

8. Claim 31, “manipulating”.

Claim 31 on file does not contain the objected expression “manipulating”.

- 9.-14. Claims 27 and 28 are deleted.

15. R₄ choice (b).

Applicants have deleted all formulas in the definition of R₄, and rely on words only, because the remarks of the Examiner indicate that the presence of words *and* formula may cause ambiguity, and “an adjacent carbon atom” is replaced in (b) by “a carbon atom adjacent to nitrogen” to remove any ambiguity. An analogous amendment is made in (c) for the ester function.

16. L = methotrexate.

Original claim 2 as filed listed “a biomolecule with desirable enzymatic, chemical and physical properties” under the definition of L. Methotrexate as a biomolecule with desirable enzymatic properties is based on the specification at page 15, lines 24/25. Furthermore claim 23 is directed to methotrexate as a label.

For these reasons, Applicants respectfully submit that the rejection of the claims under the second paragraph of 35 U.S.C. §112 should be withdrawn.

The rejection of the claims under the first paragraph of 35 U.S.C. §112, as applied to the claims remaining after entry of the foregoing amendments, is respectfully traversed.

A./B. Claim 28 is deleted.

C. One part of specific binding pair (point 5. above).

On page 14, line 7/8, examples of specific binding pairs are given, namely biotin/avidin and biotin/streptavidin.

Accordingly, Applicants respectfully submit that the rejection of the claims under the first paragraph of 35 U.S.C. §112 should also be withdrawn.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of rejection has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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